

REMARKS

The Office Action mailed November 29, 2006 considered claims 1-8 and 10-33. Claims 1, 3, 15-16, 24-25, 27-28, and 29-31 were rejected under 35 U.S.C. 103(a) as being anticipated by Corel Wordperfect 6.1, 1996, "Scan Images into Wordperfect", hereinafter *Wordperfect*, and Moseberger, D., "The Sane Scanner Interface", hereinafter *SANE*, Linux Journal, Issue 47, 3/1998, pp. 1-12. Claims 2, 6, 10, 12, and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Wordperfect*, in view of *SANE*, and further in view of "Ulead PhotoImpact 3.0" User Guide for Windows 95 and Windows NT 3.51, hereinafter *Photoimpact*, Ulead Systems, 1996, pp. 104-107, 111-1114, 162-167. Claims 4-5, 18, 21-23, and 32-33 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Wordperfect*, in view of *SANE*, further in view of Sobol et al., (US 5,907,665) hereinafter *Sobol*. Claims 7-8 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Wordperfect*, in view of *SANE*, further in view of *Photoimpact*, and further in view of Mastering Photoshop 5 for the Web, hereinafter *Photoshop* (1998, pp. 1-10). Claim 11 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Wordperfect*, in view of *SANE*, further in view of *Photoimpact*, and further in view of "Troubleshooting and configuring the Window NT/95 Registry", Clayton Johnson, hereinafter *Johnson* (1997, pp. 1-2). Claim 13 was rejected under 35 U.S.C. 103(a) as being unpatentable over *WordPerfect*, in view of *Twain*, further in view of *Photoimpact*, and further in view of TWAIN specification version 1.8, 10/22/98, hereinafter *Twain*. Claim 14 was rejected under 35 U.S.C. 103(a) as being unpatentable over *WordPerfect*, and in view of *SANE*, further in view of *Photoimpact*, and further in view of Arakawa (US 5,845,076) hereinafter *Arakawa*. Claim 19 was rejected under 35 U.S.C. 103(a) as being unpatentable over *WordPerfect*, in view of *SANE*, further in view of *Sobol*, and further in view of *Photoshop*. Claim 20 was rejected under 35 U.S.C. 103(a) as being unpatentable over *WordPerfect*, in view of *SANE*, further in view of *Sobol*, and further in view of Hearn et al, (US 6,154,756) hereinafter *Hearn*. Claim 26 was rejected under 35 U.S.C. 103(a) as being unpatentable over *WordPerfect*, in view of *SANE*, further in view of *Hearn*. Claim 31 was rejected under 35 U.S.C. 103(a) as being unpatentable over *WordPerfect*, in view of *SANE*, and further in view of *Photoshop*.¹

¹ Although the prior art status of the cited art is not being challenged at this time, Applicant reserves the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

As a preliminary matter, applicants would like to thank the Examiner for the courtesies extended during the telephonic interview of February 1, 2007.

None of the claims have been amended. Claims 1-8, and 10-33 remain pending in the application.

Each of the independent claims has been rejected based on the combination of WordPerfect in view of Sane. The Office Actions states "[i]t would have been obvious to one of ordinary skill at the time of the invention to combine Wordperfect, and Sane to access the Twain drivers using a DLL module in a Twain architecture, because of all of the reasons found in Sane including making suitable to control networked devices, reducing the number of programs needed to control image acquiring devices, and giving the user the flexibility of choosing whichever application he deemed best."

As expressed during the interview as summarized below Applicants respectfully traverse the rejections, and respectfully submit that WordPerfect and Sane may not be combined using the stated motivation.

Teaching Away MPEP 2145(X)(D)(2)

The claims of the present application are directed to allowing an image to be scanned into a document by using a special API accessed by an application program where the special API isolates a user from directly interacting with a TWAIN module to simplify the steps of acquiring the image.

References may not be combined where references teach away from their combination. MPEP 2145(X)(D)(2). SANE, when viewed as a whole, including disclosure at <http://www.sane-project.org/intro.html> last paragraph seems to clearly indicate a clear case of teaching away from the combination of SANE with any TWAIN driver. Specifically, SANE teaches that "it is unlikely that there will ever be a SANE backend that can talk to a TWAIN driver."

In response to this argument in the previous office action response, the present office action asserts "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to combine Wordperfect, and Sane to access the Twain driver using a DLL module in a Twain architecture...."

While SANE is directed at having interfaces separate from device drivers (see e.g. www.sane-project.org/intro.html at paragraph 2), SANE accomplishes this in a fashion that is contrary to how the present invention is implemented and warns away from performing the steps

recited by the present invention. Regardless of whether or not the results achieved by SANE are similar or not to the results achieved by the present invention, the result is not being claimed. Rather the claims are directed to the acts for achieving a useful result.

It would seem that the authors of SANE could clearly be classified as at least ordinarily skilled, and most likely extraordinarily skilled in the particular art in question. Yet, rather than using TWAIN drivers, the authors of SANE chose to rewrite entirely new drivers. See e.g. SANE at page marked 16 by the Examiner. Specifically, the authors of SANE note that "Agfa and Plustek scanner and Nikon filmscanner drivers are planned, and there is hope that drivers for some of the more popular digital cameras will materialize soon as well." Clearly the authors of SANE were familiar with TWAIN drivers as evidenced by the more than basic treatment of TWAIN at <http://www.sane-project.org/intro.html>. Yet rather than using existing TWAIN drivers, they chose to limit support only to those devices for which they had develop their own drivers and further warned others away from trying to combine a SANE backend with TWAIN drivers. It is clear that the authors of SANE not only do not provide motivation to combine software using TWAIN drivers with SANE, but clearly teach away from doing so.

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir.1994)). The authors of SANE indicate that "any particular TWAIN driver is pretty much married to a particular GUI API" and "it is unlikely that there will ever be and SANE backend that can talk to a TWAIN driver." Clearly one of ordinary skill in the art, such as the authors of SANE likely are, would not be motivated to combine SANE, or any other similar technology with a TWAIN driver.

In view of the foregoing, Applicant respectfully submits that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicant acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicant reserves the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicant specifically requests that the Examiner

provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine the relied upon notice with the other art of record.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney 801-533-9800.

Dated this 26th day of February, 2007.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "R. D. Nydegger", written over the printed name.

RICK D. NYDEGGER
Registration No. 28,651
J. LAVAR OLDHAM
Registration No. 53,409
Attorneys for Applicant
Customer No. 47973

RDN:JLO:crb
CRB0000003998V001